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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,211	07/23/2001	Jerlyn R. Culp	10010029-1	4896

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/911,211	Applicant(s) JERLYN RENEE ET AL	
	Examiner Mark E. Wallerson	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/26/03, 7/23/01</u> . | 6) <input type="checkbox"/> Other: ____ |

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 1-20 are pending.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statements dated 7/23/01 and 2/26/03 have been considered by the Examiner and is attached to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claims 1, 6 and 19, Applicant claims "scanning an image via an Internet receiver". It is unclear to the Examiner how the image in the invention as described could be scanned "via" the Internet receiver. The image is scanned with a stand-alone scanner (120). The scanned image may be **transmitted** via the Internet receiver, but it is unclear and not adequately described how the image is scanned via the Internet receiver.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schena et al (Schena) (U.S. 6,546,418).

With respect to claims 1 and 6, Schena discloses a method for scanning an image (column 2, lines 25-46) and transmitting it via an internet receiver (180) (column 8, lines 56-65) by automatically detecting the image (column 7, line 50 to column 8, line 5); automatically acquiring at least at least a portion of the image in electronic format (column 7, line 50 to column 8, line 5); and performing at least one function with said image (upload the image to the receiver or editing) in said electronic format via said Internet receiver (column 7, lines 61-66 and column 8, lines 56-65, and column 9, lines 43-65).

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With regard to claims 2 and 3, Schena discloses performing the at least one function comprises automatically performing at least one pre-selected function (playing the multimedia information sequence) (column 4, lines 1-8).

With respect to claims 4, 5, and 17, Schena discloses performing a final scan after performing at least one function (editing) (column 9, lines 43-65).

With regard to claim 7, Schena discloses the scanner is linked to the Inter receiver via a unidirectional or bidirectional link (figures 1 and 3).

With respect to claims 9 and 10, Schena discloses the scanner is housed together with the receiver in a set-top device or display device (column 2, lines 47-53, column 3, lines 1-8, and column 8, lines 56-65).

With regard to claim 11, Schena discloses code for automatically setting-up the scanner for operation via the Internet receiver (column 9, lines 43-65).

With respect to claims 12, 13, 14, and 18, Schena discloses part of said computer readable program code is downloaded to the Internet receiver from a network site on an as-needed basis (column 4, lines 35-46 and column 9, lines 1-65).

With regard to claim 15, Schena discloses manually selecting the function (column 7, lines 64-66).

With respect to claim 16, Schena discloses editing the image (column 9, lines 43-65).

With regard to claims 19 and 20, Schena discloses a system for scanning an image and transmitting it to an Internet receiver (column 10, lines 7-57), comprising: a scanner housed together with the Internet receiver (column 2, lines 47-56) for automatically detecting the image (column 9, lines 43-65), and for automatically acquiring said image in electronic format (column

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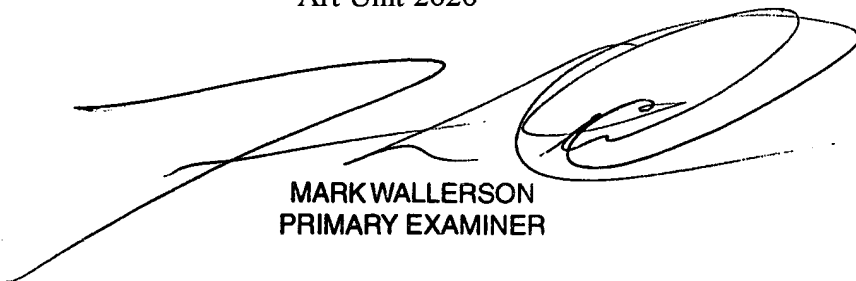
9, lines 43-65), a control module for receiving the image in the electronic format from the scanner, and for performing at least one function with the image in the electronic format via the Internet receiver (column 9, lines 43-65).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER